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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,238

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EXAMINER

SCHWARTZ, DARREN B

ART UNIT

PAPER NUMBER

2435

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,238	<b>Applicant(s)</b> ONO ET AL.	
	<b>Examiner</b> DARREN SCHWARTZ	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,6,10,14,15 and 59-61 is/are pending in the application.
- 4a) Of the above claim(s) 11,15 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,6,10,14,59 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03-24-09</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant amends claims 5, 6, 10, 11, 14 and 15. Claims 12 and 13 have been cancelled. Applicant adds claims 59-61.

### **Examiner Remarks**

In response to applicant's telephone inquiry on 28 April 2009 regarding the last Office action, the following corrective action is taken.

The period for reply of 3 MONTHS set in said Office Action is restarted to begin with the mailing date of this letter.

A complete Office Action of the last Office Action is enclosed.

### ***Election/Restrictions***

Amended claims 11, 15 and 61 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 11, 15 and 61 are directed to determining whether or not the signal is addressed to the first server, directed to a distinct species [Figure 9].

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11, 15 and 61 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Amended claims 11, 15 and 61 recite the limitation "transferring the signal to a second server when the signal is determined to be addressed to the second server" which is distinct from the limitations of claims 5, 6, 10, 14, 59 and 60.

The restriction is proper and sustained.

***Response to Arguments***

Applicant's arguments with respect to claims 59-61 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 5, 6, 10, 14, have been fully considered but they are not persuasive.

1. Applicant argues neither Holmes nor Ono discloses “a storing unit that stores the address information and the public key certificate with a validity period of the address information being se to that of the public key certificate” (REMARKS, page 30 of 31).

The Examiner disagrees.

Applicant's and applicant's representative are reminded that a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention; see *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) [MPEP: 2141.02 VI].

Holmes teaches a storing unit [“In one embodiment, the database stores a list of authorized / valid digital certificates, and optionally a list of invalid certificates. The database 150 may be located at and/or controlled by the certification authority. The database 150 may be integrated as part of the computer system 140” (§[31])] that stores the address information [Fig 200, see at least elts: 225<sub>1</sub> & 225<sub>3</sub>; Fig 4, see at least elts:

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225<sub>1</sub> & 225<sub>2</sub>; Fig 4, elts 400, 425<sub>1</sub> & 425<sub>2</sub>] and the public key certificate [¶31: "In one embodiment, the database stores a list of authorized / valid digital certificates, and optionally a list of invalid certificates" and ¶45: "digital certificate 635, and Working Certificate 500, which may be stored on mass storage 940 (Fig. 9)"] with a validity period [¶35: "The Basic Certificate may include other fields that have not been shown. Such field include, for example, a validity field specifying the period of validity of the digital certificate, a version field, etc"] of the address information [Fig 3, elt 225<sub>3</sub> and Fig 4, elt 225<sub>3</sub>] being set to that of the public key certificate [Fig 3, elts 225<sub>1</sub> & 225<sub>2</sub>; ¶34: "The certificate public key field 310 includes a traditional public key used to decrypt a digital signature." and ¶35: "The Basic Certificate may include other fields that have not been shown. Such fields include, for example, a validity field specifying the period of validity of the digital certificate, a version field, etc"]. It is noted the certificate of Holmes comprises address information and a validity period. Figure 3 teaches "setting" a Basic Certificate (300) comprising a "Name" and "Address."

The Holmes reference is upheld.

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5, 6 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes et al (U.S. Pat Pub 2002/0116610 A1), hereinafter referred to as Holmes.

Re claim 5: Holmes teaches a server that establishes a session between first and second communication devices, comprising:

a receiving unit [Fig 1, elt 140: certification authority computer system] that receives, from the first communication device [Fig 1, elt 110: subscriber computer system], a request for registering an address information on the first communication device and issuing a public key certificate of the first communication device (¶10; ¶31; ¶44);

an issuing-and-validating unit that issues the public key certificate of the first communication device to the first communication device (¶5; ¶10; ¶49); and

a storing unit [Fig 1, elt 150: central database] that stores the address information and the public key certificate with a validity period of the address information being set to that of the public key certificate (¶31; ¶35: lines 14-18; ¶45).

Re claim 6: Holmes teaches the receiving unit receives, from the second communication device [Fig 1, elt 130: recipient computer system], a request for validating the public key certificate issued to the first communication device, and the issuing-and-validating unit validates the public key certificate and indicates a result of

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the validation to the second communication device (page 2, left column, ¶28, line 17 - page 2, right column, ¶28, line 8; ¶45; ¶49).

Re claim 59: Holmes teaches the receiving unit [Fig 1, elt 140: certification authority computer system] receives, from the first communication device [Fig 1, elt 110: subscriber computer system], a request for registering an address information and a public key certificate of the first communication device (¶10; ¶31; ¶44);

the issuing-and-validating unit validates the public key certificate (¶5; ¶10; ¶49), and

the storing unit stores the address information and the public key certificate with a validity period of the address information being set to the public key certificate (¶31; ¶35: lines 14-18; ¶45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10, 14 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al (U.S. Pat Pub 2002/0116610 A1), hereinafter referred to as Holmes, in view of Ono et al (U.S. Pat Pub 2002/0035685 A1), hereinafter referred to as Ono.

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Re claims 10 and 14: Holmes teaches a method for a server to control a session between first and second communication devices and a computer readable recording medium storing a program for a server to control a session between first and second communication devices, the program making a computer execute (Abstract; ¶52-¶53):

receiving, from the first communication device, a signal for requesting a registration of an address information on the first communication device;

determining whether or not the signal includes a request for issuing a public key certificate of the first communication device to the first communication device (¶10; ¶31; ¶44);

storing the address information and the public key certificate of the first communication device with a validity period of the address information being set to that of the public key certificate (¶31; ¶35: lines 14-18; ¶45); and

transmitting, to the first communication device, a signal that indicates a completion of registering the address information and includes the public key certificate (¶5; ¶28).

However, Ono teaches:

issuing the public key certificate when the signal is determined to include the request for issuing the public key certificate (Fig 2, elt P12: ¶76).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Holmes with the teachings of Ono, for the purpose of providing explicit instructions to a serving entity; servers provide



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a plurality of functions and it is widely accepted that servers require explicit instructions of prior to executing a particular function.

Re claim 60: The combination of Holmes and Ono teaches the signal transmitted at the transmitting further includes a digital signature of the server (Holmes: Fig 3, elt 330; Fig 6, elt 635; ¶34).

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435